

Application No.: 10/807007

Case No.: 58709US004

Remarks

Claims 1 to 21 are pending. No claims have been canceled. No claims have been withdrawn from consideration. Claims 6-11 and 13 to 18 are amended to correct the antecedent. Claim 12 is amended to correct a minor typographical error. No claims have been added.

§ 112 Rejections

Claims 6-12 and 13-18 stand rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

The Office Action notes that the rejected claims recite "a chain transfer agent" for which there is no antecedent basis. The rejected claims have been amended to properly refer to the antecedent "(co)polymer". It is believed these amendments overcome the rejection. Withdrawal is respectfully requested.

Double Patenting Rejection

Claims 1-21 stand rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. 6,753,391. The Office Action asserts that "although the claims are not identical, they are not patentably distinct from each other because they both disclose a telechelic polymer and chain transfer agents having a ring opened azalactone groups and a second terminal group selected from xanthate, thioxanthate and thioester groups". The Office Action further asserts that no restriction requirement had been imposed during the prosecution of Application no. 10/429,438 that issued as U.S. 6,753,391.

Applicant's Agent notes that the rejection is in view of "claims 1-29" of the '391 patent. It is believed that the rejection should properly recite claims 1-20.

The rejection is traversed. The instant claims are directed to a telechelic (co)polymer, characterized by polymerized monomer units, and having a first azlactone terminal group and a second terminal group xanthate group, a thioxanthate group, or a dithioester group. The claims of U.S. 6,753,391 are directed to a chain transfer agent *per se*, that may be used in a polymerization to functionalize the termini of the resulting polymer. The chain transfer agent of

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the parent U.S. 6,753,391 has no "polymerized units of one or more free radically (co)polymerizable monomers" required by the instant claims. Thus, the claims are patentably distinct as a chain transfer agent and a (co)polymer.

Further, a Restriction Requirement was imposed during the prosecution of parent Application no. 10/429,438 that issued as U.S. 6,753,391. Applicants direct the Examiner's attention to the Notice of Allowance dated 2/19/2004, under Examiner's Comment. The original claims of the parent application were restricted as follows:

Group I, claims 1-13, directed to a chain transfer agent;

Group II, claims 14-20, directed to a method of polymerization; and

Group III, claims 21-29, directed to a telechelic (co)polymer.

As noted, a provisional election was made by Applicant's Agent to elect, without traverse, Groups I and II. With an Examiner's amendment, these claims issued as claims 1-20 of the '391 patent. The instant claims are directed to the invention of Group III, withdrawn under the Restriction Requirement and subsequently cancelled during prosecution.

The rejection of claims 1-21 under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. 6,753,391 has been overcome and should be withdrawn.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested. Allowance of claims 1-21, as amended, at an early date is solicited.

Respectfully submitted,

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